

Appl. No. 10/039,570  
Amendment dated July 22, 2008  
Reply to Office Action dated April 22, 2008

#### REMARKS

The U.S. Patent Examiner has made FINAL the rejections set forth in the Office Action dated April 22, 2008. In an effort to avail themselves of an Advisory Action, Applicants presented Amendment C to the United States Patent and Trademark Office within the statutory period of two months from the mailing date. In Amendment C, Applicants attempted to place the pending claims into a condition for allowance.

The U.S. Patent Examiner issued an Advisory Action dated July 9, 2008. In the Advisory Action, the U.S. Patent Examiner indicated that Amendment C was not entered because the amendments therein (1) raised new issues that would require further consideration and/or search; (2) are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and (3) require further consideration and/or search.

The content of Amendment C in its entirety has been reintroduced in this Amendment D, and certain supplemental material has been further added. Applicant proposes certain new amendments and provides the United States Patent and Trademark Office with a discussion of specific distinctions as to how the claims as amended define patentably beyond the prior art.

In the Office Action dated April 22, 2008, the U.S. Patent Examiner presented a well-reasoned statement for rejection based upon 35. U.S.C. 103(a). The thoughtful and tidy Office Action communication has been well-received and considered. The helpful assistance of the U.S. Patent Examiner is noted.

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RULES:

Section 103(a) of Title 35 of the United States Codes, reads, as follows:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made [35 U.S.C. § 103(a)].

U.S. Patent Examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. [Manual of Patent Examining Procedure (M.P.E.P.), § 2141]. Further, United States Patent and Trademark Office (Office) policy has consistently been to follow the three prong test enunciated in *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966) (*Graham*) in the consideration and determination of obviousness under 35 U.S.C. 103.

U.S. Patent Examiners are thus behooved to apply the test for patentability under 35 U.S.C. 103 as set forth in *Graham* when considering rejections of patent claims based on 35 U.S.C. 103. Furthermore, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. [M.P.E.P. § 2141.02; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)].

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (M.P.E.P. § 2413).

If a U.S. Patent Examiner does not demonstrate all elements of the *prima facie* case, the U.S. Patent Examiner's opinion of obviousness is deficient and the applicant is deserving of a patent. The Federal Circuit has endorsed this view in *In re Oetiker*, stating, "if the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443-1444 (Fed. Cir. 1992).

An applicant who is able to prove that any one of these elements is not present will effectively prevent the *prima facie* case of obviousness from being established. Notably, the three prong test enunciated in *Graham* was most recently upheld by the U.S. Supreme Court ruling in *KSR International Co. v. Teleflex Inc. et al.*, 127 S. Ct. 1727 (2007).

In this last regard, it is noted that on April 30, 2007, the U.S. Supreme Court unanimously reversed the judgment of the Federal Circuit, holding that the disputed claim 4 of the patent at issue (U.S. Patent No. 6,237,565) was obvious and that in "rejecting the District Court's rulings, the Court of Appeals analyzed the issue in a narrow, rigid manner inconsistent with §103 and our precedents," referring to the Federal Circuit's application of the teaching-suggestion-motivation (TSM) test.

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As is well known, the combination of previously known elements can be considered obvious. As stated by Winner Int'l Royalty Corp. v. Wang, 202 F.3d. 1340, 1348 (Fed. Cir., 2000), there must be a suggestion or teaching in the prior art to combine elements shown in the prior art in order to find a patent obvious. Thus, the critical inquiry is whether there is something in the prior art to suggest the desirability, and thus the obvious nature, of the combination of previously known elements.

The foregoing is the "teaching-suggestion-motivation" or TSM test and serves to prevent against hindsight bias (*In re Kahn*, Fed. Cir. 2006). As almost all inventions are some combination of known elements, the TSM test requires a patent examiner to show that some suggestion or motivation exists to combine known elements to form a claimed invention. In *KSR*, the Court held that, while the ideas behind the TSM test and the Graham analysis were not necessarily inconsistent, the true test of nonobviousness is the Graham analysis.

Justice Kennedy's opinion stated, "A person of ordinary skill is also a person of ordinary creativity, not an automaton." He acknowledged that his description of a person having ordinary skill in the art does not necessarily conflict with other Federal Circuit cases that described such a person as having "common sense" and who could find motivation "implicitly in the prior art." Kennedy was careful to emphasize that his opinion was directed at correcting the "errors of law made by the Court of Appeals in this case" and did not necessarily operate to overturn all other Federal Circuit precedent.

When generally describing the obviousness test, the Court was largely uncontroversial:

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"In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under §103. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims."

However, when the standard was applied to the facts before the Court, the Court stated, as follows:

"The proper question to have asked was whether a pedal designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrading [a prior art patent] with a sensor."

The KSR opinion further denounces procedures that bar the use of "common sense" in multiple instances, including where "[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it." Chief Judge Paul Michel of the Federal Circuit was quoted saying that by his interpretation, the TSM test remains part of the calculation of obviousness, "but it gives us forceful instruction on the manner in which the test is to be applied."

It is further noted that in *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, No. 05-1631 (Fed. Cir. May 9, 2007), the Federal Circuit began applying the KSR case, holding

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U.S. Patent 5,813,861 invalid as obvious. Further, statistics support a finding that the USPTO Board of Patent Appeals and Interferences (BPAI) is now citing KSR in about 60% of its decisions related to obviousness irrespective of whether it affirms a patent examiner's rejection or reverses the rejection. Overall reversal rates have stayed about the same, indicating that KSR has not suddenly made all inventions obvious.

The BPAI is emphasizing that examiners must still give strong reasons for their rejections. The USPTO management has backed this up with a memorandum to all technology directors instructing them that when making an obviousness rejection "it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

#### ANALYSIS

A primary feature supporting the practice of the present invention is the raked fork members for positioning the in-line wheels centrally relative to the board ends such that the vertical pivot axes lie outside the diameter of said wheels to effect better control of board movement via one's shifting weight substantially as claimed and supported in the accompanying specification.

Applicants elected to amend the claims to more succinctly and precisely claim the invention they regard as their invention. In this regard, the Applicants direct the U.S. Patent Examiner's attention to Figure No. 1 in the subject application. There it may be seen that the truck assemblies each comprise a raked fork member for positioning the wheels centrally relative to the vertical pivot axes. Notably, the pivot axes lie outside the diameter of the wheels.

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Such placement of the wheels is believed to be superior over the prior art in that the same effects a more predictable, manageable board control under shifts in the rider's weight. Neither the Rue disclosure, nor the Kimmel disclosure appears to teach such a construction. Applicants note that the U.S. Patent Examiner may well find it beneficial to re-search the prior art in an attempt to uncover pertinent art relating to this structural feature.

In any event, however, the independent claims in this application have been amended to reflect this structural limitation, and are believed to more accurately and succinctly define the invention that Applicants regard as their invention insofar as the claimed limitations are believed to be unobvious in view of the prior art currently cited against the claims by the examiner.

Noting that all of the claim limitations must be taught or suggested, the claims as currently amended set forth certain structure that the prior art or one of ordinary skill would simply not teach or suggest. Thus, all three prongs of the Graham test fail for the cited prior art with the claims as currently amended.

Further, if one were to pose the question as to whether a skate board designer of ordinary skill, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to upgrading Rue or Kimmel with the offset in-line wheels as currently claimed, it is highly doubtful that the returned answer would be affirmative.

It is noted that truck assemblies of various forms are generally well known and thus a skate board designer of ordinary skill may arguably have seen a benefit to upgrading Rue or Kimmel with various state of the art truck assemblies. However, it is

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doubtful that the a skate board designer of ordinary skill would have seen a benefit of upgrading Rue or Kimmel with the specific truck assemblies and surrounding structures as structurally defined in the pending claims (as currently amended).

CONCLUSIONS:

Applicants point out that claim language is purposeful and not accidental. The noted limitations as now appearing in the pending claims have been purposefully recited in an effort to properly claim the subject matter that Applicants regard as their invention. It is Applicants' contention that the U.S. Patent Examiner's purported opinion of obviousness is deficient, particularly in view of the claims as currently amended, and that Applicants are deserving of the allowance of the pending claims, and such action is kindly requested. If, after a review of this Amendment, issues remain which may be resolved by a telephone interview, the U.S. Patent Examiner is cordially invited to call the Applicants' undersigned attorney.

Respectfully submitted,  
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